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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/383,508	08/26/1999	PATRICK J. RYAN	AMDA.389DIV1	6687

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EXAMINER

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ART UNIT	PAPER NUMBER
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3653

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 21

Application Number: 09/383,508
Filing Date: August 26, 1999
Appellant(s): RYAN ET AL.

Eric J. Curtin
For Appellant

MAILED

DEC 13 2002

GROUP 3600

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/1/02.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are that the 35 U.S.C. 112, first paragraph rejections have been withdrawn thus the only issues remaining on appeal are as follows:

Issue 1: Whether the Examiner Applied the Correct Legal Test and Rationale in Support of the Rejection made under 35 U.S.C. 112, Second Paragraph.

Issue 2: Whether the rejection under 35 U.S.C. 112, Second Paragraph is Proper when the Claim Language is Inconsistent with the Specification.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with as the scope of all the claims are rendered indefinite by the 35 U.S.C. 112, second paragraph issues addressed below.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6-12 and 19 are rejected under 35 U.S.C. 112, second paragraph.

This rejection is set forth in prior Office Action, Paper No. 16.

(11) *Response to Argument*

Issue 1: The Rejection under 35 U.S.C. 112, second paragraph is Proper as the Legal Test and Rationale applied by Examiner have Ample Legal Support.

The legal test presented by Examiner is clearly proper as it is well-established that claim language can be indefinite under 35 U.S.C. 112, second paragraph if

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inconsistency exists between the claim language and the specification. The MPEP states-

Although the terms of the claim may appear to be definite, inconsistency with the specification disclosure or prior art teachings may make an otherwise definite claim take on an unreasonable degree of uncertainty. See MPEP 2173.03 (citing *In re Cohn*, 438 F.2d 989, 169 USPQ 95 (CCPA 1971) and *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970)).

Here, the claim language “bays” (claim 1, ln. 3; claim 19, ln. 3) and “docking locations” (claim 10, ln. 2) is in conflict with the specification, as more fully explained below, thus it is unclear how Applicant can claim that a legal test that has unambiguous support in the MPEP as well as case law is the “wrong test”. Applicant fails to explain, or even address, how the above-cited precedent is inapplicable and attempts to skirt the issue by inserting an alternative legal test and making legally irrelevant arguments. Consequently, in view of existing legal precedent, Applicant’s assertions are misplaced as the correct legal test has been applied in establishing the indefiniteness of Applicant’s claim language.

Issue 2: The Rejection under 35 U.S.C. 112, Second Paragraph is Proper as the Claim Language is Inconsistent with the Specification.

The claim features of “bays” (claim 1, ln. 3; claim 19, ln. 3) and “docking locations” (claim 10, ln. 2) associated with the reticle sorter are inconsistently defined in the specification, thus rendering the scope of the claims indefinite. In particular, the feature of “bays” is described as included in the reticle sorter in the “Summary of the Invention” (Spec., p. 2, ln. 24-25) and is also used to describe a “fabrication area” in the prior art (Fig. 1, bay 110; Spec., p. 2, ln. 28). The feature of “docking locations” is used

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in the "Detailed Description" and is illustrated as a feature of the reticle sorter (Fig. 3A, docking location 310; Spec., p. 5, ln. 24-25). The relationship of these features, however, is unclear. More particularly, Applicant has failed to specifically illustrate or describe the "bays" in the "Detailed Description" of the reticle sorter and in figure 3A, which teaches the entire reticle sorter, thus it is unclear whether the "bays" and "docking locations" are the same or different features. The claim language uses both features when describing the reticle sorter, thus it logically follows that the features are separate. However, if the two features are separate, it is unclear where the bays are located as the "bay" feature is not illustrated and is only described in relation to the reticle sorter in the "Summary of the Invention" (Spec., p. 2, ln. 24-25 stating that "reticle sorter includes one or more bays"). This ambiguity between the specification and the claims begs for clarification, as the placement and relationship of the claim features are not clear, thus rendering the scope of the claims indefinite.

Further, Applicant's own arguments have compounded the issue of the relationship between the "bays" and "docking locations" by arguing for two different, unworkable interpretations of the claim language and specification. For example, Applicant himself has argued that the two limitations at issue define the same claim feature by stating

Figure 3 illustrates a reticle sorter with **two bays (a.k.a., docking locations)**, each bay holding a cassette having slots for reticles. Clearly, **the word "bay" is used to describe an area of the reticle sorter in one location of the specification (page 2, lines 24-25), and the phrase "docking location" is used to describe the same area** in another location of the specification (page 4, lines 24-25); it would be plainly apparent to the skilled artisan that the specification used the terms "bay" and the phrase "docking location" interchangeably and synonymously to

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describe an area of the reticle sorter that holds a cassette with slots for reticles. (After Final Response, dated 7/08/02, page 2, excerpt from 2nd full para., **emphasis added**)
In contrast, in the instant Appeal, Applicant now argues that the two claim limitations define separate features. The claim language and its supporting specification cannot reasonably apprise those with skill in the art of the scope of the invention if Applicant himself cannot correctly determine the scope of his own invention. In view of the above, the specification introduces an unreasonable degree of uncertainty into the claim language and thus, by any legal measure, Applicant's claims are indefinite.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

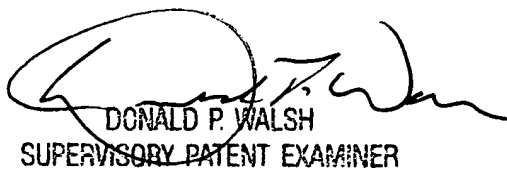

Examiner Joseph Rodriguez

December 10, 2002

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